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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,803	04/30/2001	James Sachs	20694N008000	5184

20350 7590 08/12/2004

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EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/846,803

Applicant(s)

SACHS ET AL.

Examiner

Jonathan D. Schlaifer

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is response to application 09/846,803 filed on 4/30/2001, with no prior art filed.
2. Claims 1-21 are pending in the case. Claims 1 and 12 are independent claims.

#### *Claim Objections*

3. Claim 2 objected to because of the following informalities: In line 2 of the claim, "upload" should be "uploads". Appropriate correction is required.

#### *Claim Rejections - 35 USC § 103*

4. **Claims 1-2, 4-5, 10-15 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan (USPN 5,761,485—filing date 12/1/1995), further in view of Harvey et al. (USPN 6,487,581 B1—filing date 2/25/2000), hereinafter Harvey.**
5. **Regarding independent claim 1**, Munyan discloses a system to distribute electronic publications (the invention is directed towards distributing an electronic book), comprising: a portent electronic book adapted to receive and interface with a removable storage device storing electronic photographs generated by a digital camera (in the Abstract, lines 1-30, Munyan describes an electronic book that stores electronic photographs) and it was notoriously well known in the art at the time of the invention that digital cameras are a common source of electronic photographs because they represent a convenient way to obtain and manage high-quality photographs, hence it would have been obvious to one of ordinary skill in the art at the time of the invention to obtain the photographs from a digital camera because they represent a convenient way to obtain and manage high-quality

photographs. However, Munyan fails to disclose an information services system including a centralized bookshelf and a personal photo albums module associated with the portable electronic book, the centralized bookshelf including electronic reading materials requested and owned by the portable electronic book, the personal photo albums module including electronic photographs owned by the portable electronic book. However, Harvey, in col. 4, lines 20-45, discloses the use of owned electronic photo albums to help manage digital images in a convenient way and effectively control their use. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used electronic photo albums as disclosed in Harvey in the context of Munyan to help manage digital images in a convenient way and effectively control their use.

6. **Regarding dependent claim 2**, Munyan fails to disclose that the portable electronic book extracts the electronic photograph from the removable storage device and uploads the electronic photograph to the personal photo albums module. However, Harvey, in the Abstract, lines 1-15, discloses "invitation applications", which would necessarily lead to the solicitation and transmission of photographs from the electronic book to the library. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used uploading from the book as disclosed in Harvey in the context of Munyan in order to allow expansion of the library based on the contents of individual books.
7. **Regarding dependent claim 4**, Munyan and Harvey fail to disclose that the electronic photographs are JPEG (Joint Photographic Experts Group) files. However, it was notoriously well known in the art at the time of the invention that

JPEG's are a standard photo format with low space requirements it would have been obvious to one of ordinary skill in the art at the time of the invention to have used JPEG to store the photos in Munyan and Harvey's inventions because it was a standard photo format with low space requirements.

8. **Regarding dependent claim 5**, Munyan fails to disclose that the person photo albums module includes a plurality of photo albums, and each of the plurality of photo albums is capable of storing a plurality of electronic photographs.

However, Harvey in col. 4, lines 20-45, discloses the use of multiple objects, each of which may be a photo album containing a plurality of electronic photographs.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a plurality of albums containing a plurality of photographs in the manner of Harvey because it would have allowed organized archival of visual information about a given topic.

9. **Regarding dependent claim 10**, Munyan discloses in col. 3, lines 45-60 that an electrical communications link is used by the portable electronic book to interface with an information services system.

10. **Regarding dependent claim 11**, Munyan discloses in col. 3, lines 45--60 that a modem is used by the portable electronic book to interface with an information services system, and since it was notoriously well known in the art at the time of the invention that a high-speed modem increases transfer rate for data transmissions, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a high-speed modem to increase transfer rate for data transmissions.

11. **Regarding independent claim 12**, it is the method performed by the system of claim 1, and it is rejected under similar rationale.
12. **Regarding dependent claim 13**, it is the method performed by the system of claim 2, and it is rejected under similar rationale.
13. **Regarding dependent claim 14**, it is the method performed by the system of claim 4, and it is rejected under similar rationale.
14. **Regarding dependent claim 15**, it is the method performed by the system of claim 5, and it is rejected under similar rationale.
15. **Regarding dependent claim 20**, it is the method performed by the system of claim 10, and it is rejected under similar rationale.
16. **Regarding dependent claim 21**, it is the method performed by the system of claim 11, and it is rejected under similar rationale.
17. **Claims 3, 6-7, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan, further in view of Harvey, further in view of Shaffer et al. (USPN 6,434,579 B1—filing date 8/19/1998), hereinafter Shaffer.**
18. **Regarding dependent claim 3**, Munyan and Harvey fail to disclose that the removable storage device is a flash memory card. However, Shaffer, in col. 3, lines 60-65 discloses the use of flash memory cards to store images in a photo gallery. It would have been obvious to one of ordinary skill in the art at the time of the invention to have stored photo gallery images from Munyan and Harvey in the manner of Shaffer in order to provide a portable and durable storage medium for the photographs.

19. **Regarding dependent claim 6**, Munyan and Harvey fail to disclose a system wherein the portable electronic book displays thumbnails to a user, each of the thumbnails represents on e electronic photograph stored on the removable storage device. However, Shaffer, in the Abstract, lines 5-10, discloses the use of thumbnails in displaying a photo album to aid navigation of the photo album. It would have been obvious to one of ordinary skill in the art at the time of the invention to display thumbnails to aid navigation of the photo album.
20. **Regarding dependent claim 7**, a page turning mechanism to enable a user to scroll through different sets of thumbnails would be inherent to having a collection of thumbnails, because otherwise if the entire collection of thumbnails could not be displayed simultaneously, there would be no way to access the entire collection.
21. **Regarding dependent claim 16**, it is the method performed by the system of claim 6, and it is rejected under similar rationale.
22. **Regarding dependent claim 17**, it is the method performed by the system of claim 7, and it is rejected under similar rationale.
23. **Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan, further in view of Harvey, further in view of Tamagaki (USPN 5,999,646—filing date 3/7/1997).**
24. **Regarding dependent claim 8**, Munyan and Harvey fail to disclose that the portable electronic book scales an electronic photograph selected from the electronic photograph selected from the electronic photographs stored on the removable storage device. However, in col. 9, lines 60-67 and col. 10, lines 1-10,



Tamagaki discloses image processing of an image which involves scaling to allow copying to fit given size requirements. It would have been obvious to one of ordinary skill in the art at the time of the invention to have scaled an image in the manner of Tamagaki in the context of Munyan and Harvey in order to have allowed copying of images to fit given size requirements.

25. **Regarding dependent claim 18**, it is the method performed by the system of claim 8, and it is rejected under similar rationale.

26. **Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan, further in view of Harvey, further in view of Reavey et al. (USPN 5,847,698—filing date 9/17/1996), hereinafter Reavey.**

27. **Regarding dependent claim 9**, Munyan and Harvey fail to disclose that the portable electronic book rotates an electronic photograph selected from the electronic photographs stored on the removable storage device. However, Reavey notes in col. 7, lines 24-26, "Electronic book device **100** can automatically rotate text and graphics on the display panel to change the screen orientation." It would have been obvious to one of ordinary skill in the art at the time of the invention to have allowed photo rotation in the manner of Reavey in the context of Munyan and Harvey in order to have allowed the user to change the screen orientation.

28. **Regarding dependent claim 19**, it is the method performed by the system of claim 9, and it is rejected under similar rationale.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,379,057 (filing date 7/28/1993)—Clough

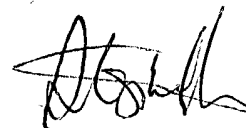
USPN 5,339,091 (filing date 10/14/1992)—Yamazaki et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 703-308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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JS



**STEPHEN S. HONG  
PRIMARY EXAMINER**